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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/735,141	12/12/2000	James J. Fitzgibbon	70333	5535

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FITCH EVEN TABIN AND FLANNERY  
120 SOUTH LA SALLE STREET  
SUITE 1600  
CHICAGO, IL 60603-3406

EXAMINER
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LINNENKAMP, NICHOLAS L

ART UNIT	PAPER NUMBER
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2635

DATE MAILED: 11/06/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/735,141

Applicant(s)

FITZGIBBON ET AL.

Examiner

Nicholas L Linnenkamp

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 4/16/2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12-2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7,8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. Figures 2-15 are objected to as failing to comply with 37 CFR 1.84(p)(5) because they are unlabeled as to all of the reference sign(s) mentioned in the description. In addition, reference sign 10, 39, 39a, 39b, 39c, and 39d are indicated in the description as being shown on Figure 1 but are absent from the Figure. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

2. The disclosure is objected to because of the following informalities:

On page 2, lines 29 –33 of specification, "...ease of establishing the identity to the user to be granted access by either receiver or transmitter...", are confusing as to content. To clear up confusion applicant should re-word phrase to remove dependency between "user" and "granted" such as, "...ease of establishing the identity to the user and be granted access by either receiver or transmitter..."

On page 5, line 2 of specification, "of the" repeated twice. Recommended correction is to remove extraneous "of the".

On page 16, line 33 of specification, "perform am appropriate" should read "perform an appropriate".

Appropriate correction of the above-mentioned objections is required.

***Claim Objections***

3. Claim 3 is objected to because of the following informalities: citing the use of an "electroiluminescent fingerprint sensor" which is not the accepted spelling of the word "electroluminescent" or "electro luminescent". Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1,2, and 6-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Andreou et al.

In reference to Claim 1, Andreou et al. teaches of a movable barrier such as the door with remote-activated lock attached. Andreou et al. teaches of a fingerprint sensor for performing identity authentication (Col 19, lines 42-44). Andreou et al. teaches an Electronic Door Lock (EDL) to assume one of two states, locked or unlocked, which was viewed as a barrier operator circuit for commanding a barrier to assume a particular position (Col 15, lines 5-10). Andreou et al. teaches the connection of a photodiode array for fingerprint pattern recognition (Col 19, lines 28-38). Andreou et al. teaches of using a direct connection as a transmission medium between MPU (505) and Scanner (512) (Figure 7), thus inherently including some type of transmitting and receiving

structure. Andreou et al. teaches of Micro Processing Unit (MPU) for authenticating an incoming signal (Col 15, lines 19-25).

In reference to Claim 2, Andreou et al. teaches that fingerprint sensor is an optical fingerprint sensor (Col 19, lines 40-45).

In reference to Claim 6, Andreou et al. teaches of an EDL, which was viewed as a transmitter that comprises a wall control.

In reference to Claim 7, Andreou et al. teaches of memory for use in the MPU (Col 15, lines 19-25).

In reference to Claim 8, Andreou et al. teaches of using coded signals that must be verified before lock operation (Col 5, 52-58). Andreou et al. teaches that the MPU sends a signal to the Parallel Input Output (PIO) unit for causing barrier to assume different positions (Col 17, lines 1-4).

In reference to Claim 9, Andreou et al. teaches of using optical pattern recognition in the EDL thus performing positive identification of fingerprints (Col 19, lines 44-45).

Thus Andreou et al. teaches all the claim limitations of claims 1,2,and 6-9.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Andreou et al. in view of Nicholls<sup>v</sup> Andreou et al. teaches all the limitations of claims 1 and 2.

Andreou et al. does not teach the use of electroluminescent fingerprint sensors.

Nicholls teaches of an electroluminescent fingerprint sensor such as TactileSense<sup>™</sup> by Who?Vison<sup>™</sup> as an improvement over other common fingerprint sensors. It would have been obvious to one skilled in the art at the time of invention to substitute Andreou et al.'s optical fingerprint sensor for Nicholls electroluminescent fingerprint sensor since Nicholls discloses an advantage of electroluminescent fingerprint sensors over existing fingerprint sensors, such as the immunity to the 'dry finger problem' that existed in fingerprint sensing technologies at the time of invention (Nicholls, pp 5). Who?Vison<sup>™</sup> also suggests the integration of such sensors into physical access control devices ("xlvision.com/spinoffs").

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Andreou et al. in view of Toyoda et al. Andreou et al. teaches all the limitations of claim 1 and 2.

Andreou et al. does not teach the use of Charged Coupled Devices (CCDs). Toyoda et al. teaches the use of CCDs to sense fingerprints in the production of identity authentication devices (Fig. 1). It would have been obvious to one skilled in the art at the time of invention to substitute Andreou et al.'s optical fingerprint sensor for Toyoda et al's identity authentication device using a CCD since Toyoda et al suggest that his device be used to manage entrance and exit of individuals in restricted areas (Col 1, lines 38-40) and the use of Toyoda et al's identification device using CCD would provide an improved individual identification apparatus with a high recognition ability (Col 2, lines 38-42).

9. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Andreou et al. in view of Fishbine et al. Andreou et al. teaches all the limitations of claim 1 but does not teach of using RF signals to transmit the representative fingerprint. Fishbine et al. teaches the use of RF signals to transmit the captured fingerprints by a hand held unit to a central location (Col 2 lines 13-17). It would have been obvious by one skilled in the art at the time of invention to use the handheld fingerprint-sensing RF transmitter of Fishbine et al. in the device of Andreou et al. because Fishbine et al. suggests that such a system would be useful to field-capture a fingerprint and make an identity match (Col 2, lines 10-13) and Andreou et al. suggest that the HHC could be replaced with positive identification of fingerprints (Col 19, lines 42-44).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas L Linnenkamp whose telephone number is (703) 305-8701. The examiner can normally be reached on 8:00-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (703) 305-4704. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.

Nicholas L Linnenkamp  
Examiner  
Art Unit 2635

NLL

MICHAEL HORABIK  
SUPERVISORY PATENT EXAMINER  
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